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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,504	02/05/2001	Andrew A. Erlichson	11032/3014	8473

7590

06/30/2004

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EXAMINER

DURAN, ARTHUR D

ART UNIT	PAPER NUMBER
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3622

DATE MAILED: 06/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/775,504

Applicant(s)

ERLICHSON ET AL.

Examiner

Arthur Duran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 February 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

1. Claims 1-37 have been examined.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claim 1-13, 16, 19-24, 27-32, 35-37 are rejected under 35 U.S.C. 102(e) as being anticipated by Eggleston (6,061,660).

Claim 1, 7, 13, 16, 19, 27, 35, 36, 37: Eggleston discloses a method, computer arrangement, machine-readable medium for conducting an online sweepstakes over a computer network, comprising the steps of:

- (a) providing to a user on a computer network a design interface for designing a sweepstakes form, the design interface associated with functionality for altering the appearance of the sweepstakes form based upon input from the user (Fig. 9, Fig. 15; Fig. 19; col 5, lines 45-55);
- (b) receiving the input from the user via the computer network for altering the appearance of the sweepstakes form (Fig. 9, Fig. 15; Fig. 19; col 5, lines 45-55);
- (c) generating electronically a revised sweepstakes form based upon the input from the user (Fig. 9, Fig. 15; Fig. 19; col 5, lines 45-55);

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- (d) receiving contact information from an online sweepstakes entrant via an online entry form associated with the online sweepstakes (col 6, lines 1-13); and
- (e) providing a communication interface to the user, the communication interface using the contact information to allow the user to communicate with the online sweepstakes entrant over the computer network (Fig. 2; Fig. 4; col 11, lines 24-26; col 6, lines 30-46).

Eggleston further discloses that the user can be a marketer or that a sponsor can be the same as or different than a host (col 7, line 53- col 8, line 20)

Eggleston further discloses a communications device, a processor (col 10, lines 10-43; Fig. 1).

Claim 2, 8, 20, 28: Eggleston discloses the method, computer arrangement according to claim 1, 7, 19, 27 wherein the design interface includes a Web page resembling the sweepstakes form, the Web page associated with an editing button, the editing button linking to the functionality for altering the appearance of the sweepstakes form (Fig. 19; Fig. 6).

Claim 3, 9, 21, 29: Eggleston discloses the method, computer arrangement according to claim 2, 8, 20, 28 wherein the functionality for altering the appearance of the sweepstakes form includes the substep of

- (d) prompting the user via the computer network to specify an attribute of the sweepstakes form (Fig. 19; Fig. 6; col 5, lines 47-55; col 6, lines 13-20).

Claim 4, 10, 22, 30: Eggleston discloses the method, computer arrangement according to claim 3, 9, 21, 29 wherein the attribute of the sweepstakes form includes at least one of a question to be presented to the entrant on the sweepstakes form, a maximum permissible length of an entrant response in characters, whether a question to be presented to an entrant begins on a

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new line in the sweepstakes form, an instruction field associated with a question, and a type of question to be presented to the entrant (col 13, lines 42-55).

Claim 5, 11, 23, 31: Eggleston discloses the method, computer arrangement according to claim 1, 7, 19, 27 further comprising the steps of:

- (d) receiving an indication from the user relating to sweepstakes parameters (col 5, lines 49-55); and
- (e) generating electronically a legal rule based upon the indication received from the user (col 32, line 4-16; col 12, line 64-col 13, line 6).

Eggleston also discloses discouraging fraud (col 42, lines 41-45).

Claim 6, 12, 24, 32: Eggleston discloses the method, computer arrangement according to claim 1, 7, 19, 27 further comprising the steps of:

- (d) providing the user with a winner-drawing interface for randomly selecting winners of the online sweepstakes (col 32, lines 30-35; col 31, lines 51-57; col 35, lines 20-26).

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claim 14, 15, 17, 18, 25, 26, 33, 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eggleston (6,061,660).

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Claim 14, 17, 25, 33: Eggleston discloses the method, computer arrangement according to claim 13, 16, 19, 27

wherein the contact information includes an email address (col 13, lines 9-16).

Eggleston does not explicitly disclose that the marketer communicates with the online sweepstakes entrant via email.

However, Eggleston further discloses the entrant emailing the marketer (col 12, lines 34-37), the utilization of free communications (col 5, lines 60-65; Fig. 2), and advertising (col 1, lines 35-45).

Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to utilize the consumer's email as a medium for free communications. One would have been motivated to do this in order to provide promotions or advertising to the consumer in a convenient, familiar medium such as email.

Claim 15, 18, 26, 34: Eggleston discloses the method, computer arrangement according to claim 14, 17, 25, 33.

Eggleston does not explicitly disclose that the communication interface allows the marketer to track a response by the online sweepstakes entrant to an email message sent to the online sweepstakes entrant by the marketer.

However, Eggleston discloses the utilization of email (col 13, lines 9-16) and free communications (col 5, lines 60-65, col 12, lines 34-37; Fig. 2).

Eggleston further discloses tracking numerous aspects of consumer communication with the marketer including responses by the online sweepstakes entrant to a message (13, lines 5-29).

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Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to add Eggleston's consumer email information to Eggleston's free communication and tracking of consumer responses. One would have been motivated to do this in order to permit user email communications to provide further information for consumer psychographic and demographic profile formation.

### ***Conclusion***

The following prior art made of record and not relied upon is considered pertinent to applicant's disclosure:

a. Storey (5,774,870) discloses utilizing email with users and awards, prizes, and promotions.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Arthur Duran whose telephone number is (703)305-4687. The examiner can normally be reached on Mon- Fri, 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber can be reached on (703)305-8469. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

A handwritten signature in cursive script, appearing to read "Arthur Duran".

Arthur Duran  
Patent Examiner  
6/21/04